Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI ISHIBASHI, YASUSHI KOBAYASHI, YASUMASA SUGIHARA, YASUSHI TANIJIRI, and HIDEKI NAGATA

Appeal No. 2002-1655
Application No. 08/988,537

ON BRIEF

Before HAIRSTON, JERRY SMITH, and LEVY, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4 and 23-26. Claims 5-22 have been allowed.

BACKGROUND

Appellants' invention relates to an image observation device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. An image observation apparatus comprising:

a main body which has an image display device;

an operational member which is provided on the main body and which is operated manually in order to give an instruction to the image observation apparatus;

a detector for detecting a posture of the main body; and

a controller for controlling an image which is displayed on the image display device in response to a signal which is output from the detector,

wherein the controller does not allow changing the image which is displayed on the image display device in response to the signal which is output from the detector when the operational member is operated.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tabata	5,579,026	Nov. 26, 1996
Tosaki	5,844,530	Dec. 1, 1998 (filed Dec. 7, 1995)
Kodama	6,124,843	Sep. 26, 2000 (filed Jan. 25, 1996)

Claims 1, 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Tosaki.

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tabata in view of Tosaki, and further in view of Takasu.

Claims 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Tosaki, and further in view of Kodama.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 30, mailed January 29, 2002) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 29, filed November 13, 2001) and reply brief (Paper No. 31, filed March 13, 2002) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the

examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

We begin with the rejection of claims 1, 23, and 25, under 35 U.S.C. § 103(a) as unpatentable over Tabata in view of Tosaki. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 4) is that Tabata discloses controlling an image displayed on the image display device in response to a signal which is output from the detector, but that Tabata does not teach providing the controller on the main body. The examiner further asserts (id.) that Tabata does not teach that the controller stops controlling the displayed image when the operational member 11 is operated. To make up for these deficiencies of Tabata, the examiner turns to Tosaki for a disclosure of an image display having a pause switch for temporarily stopping the game. The examiner asserts (answer, page 6) that it would have been obvious to provide Tabata with a pause switch that stops (freezes) the changing of the image on

the display, to allow the user to temporarily stop the game and return to where they left off. The examiner notes that the claimed operational member reads on Tosaki's pause switch, because once the pause switch is operated, no changing of the image is allowed. With respect to the claimed limitation that the controller is mounted on the main body, the examiner asserts (answer, page 5) that:

> Both Tabata and Tosaki devices are head mounted. Thus, the obvious position of the operational switches to be in the user's hand. However, if either Tabata or Tosaki device is to be surface mounted display, the obvious design to the switches to be provided on the main body so that to add to the portability of the device. Furthermore, to allow easily operation of the device. Furthermore, Tosaki (figure 14) shows the user operating the device using a device held in the user's hand.

Appellants assert (brief, page 7) that the applied art, in combination, does not disclose the controller recited in the independent claims. Appellants note that in Tosaki, when the visor is moved, switch 92 shuts off fluorescent tube 71. Appellants argue to the effect that this means that images are no longer projected because they are no longer lit, but are still being generated, until such time that the pause switch is pressed, to temporarily stop the game. It is argued that Tosaki cannot meet the recitation of the controller not allowing the

changing of an image since no image is displayed once the visor is moved to the up position.

We note at the outset that appellants do not argue the combinability of Tabata and Tosaki, but rather that the teachings of Tabata and Tosaki do not teach or suggest the claimed invention. From the disclosure of Tosaki, we find two references to the use of the pause button. Tosaki discloses (col. 16, lines 22-38) that:

> If a better perception of the external environment is to be achieved in the course of a game, the visor 80 is opened by being turned upward about the fulcrums 80L and 80R. This increases the quality of outside light that enters the display device 2 from the outside, opens the switch 92 of the fluorescent tube 71, and stops the images from being projected on the display device 2. The external environment can therefore be clearly perceived even when the HMD 1 is still worn. It is also possible at this time to depress the pause switch on the control pad 201 and to temporarily stop the game. To resume the game, the visor 80 should be turned downward about the fulcrums 80L and 80R, the switch 92 of the fluorescent tube 71 closed, and the fluorescent tube 71 lighted. If the game is temporarily stopped, the pause button on the control pad 201 should be depressed again to cancel the pause mode.

Tosaki further discloses (col. 18, lines 32-34) that "[a]nother option is to connect the HMD 1 pertaining to the present embodiment with a holding device that puts the game in a pause mode when the visor 80 has been opened."

From the two disclosures of Tosaki, we find that in each instance where the pause button is referred to, it is in the context of being pressed either after the visor is lifted or at the same time the visor is lifted. Upon lifting the visor on the HMD 1 upwardly about the fulcrums 80L and 80R, switch 92 of fluorescent tube 71 is opened, which stops the image from being displayed. We agree with appellants (brief, page 7) that stopping the images from being displayed is not the same as stopping the game, and find that although the images will not be displayed, that the game will continue and that the images will be changing, even though the images cannot be seen by the player. However, from the disclosure of providing a pause switch 201 for temporarily stopping the game, we find that upon stopping the game by depressing the pause switch, the pausing of the game stops the images from changing.

From our review of Tosaki, we are persuaded by appellants' assertion (id.) that in Tosaki, the pause switch cannot stop the displayed image from changing, because the image is already shut off when the visor is lifted, prior to operation of the pause button. We are not persuaded by the examiner's assertion (answer, page 9) that the pause switch is operable without first lifting the visor. As stated, supra, in each of the two

instances where the pause switch is referred to, it is in the context of being operated either after the visor is lifted and the fluorescent tube is shut off, or at the same time that the visor is lifted and the fluorescent tube is shut off. In either instance, because the fluorescent tube displaying the image is shut off, the controller cannot prevent the displayed image from changing, since the image is not being displayed. We find this to be supported by the language in Tosaki (col. 16, line 30) that "[i]t is also possible at this time to depress the pause switch." We find that the language "at this time" refers to the time after the visor has been lifted and the fluorescent tube, which displays the images, has been turned off. Thus, we find that the pause switch is depressed either at the same time or after the visor is lifted. However, we find no teaching or suggestion in Tosaki for operating the pause button without lifting the visor. To find otherwise, as advanced by the examiner, we would have to resort to speculation as to what would have been obvious based upon common sense. Thus, we find the examiner's position to be unsupported by any objective evidence in the record; See In re Lee, 61 USPQ2D 1430, 1433 (Fed. Cir. 2002). In sum, because we find that there is no disclosure in Tosaki of using the pause switch without lifting the visor, we find that Tosaki does

suggest preventing changing of the image (or not allowing the image to change), but does not teach or suggest preventing changing of the displayed image, as required by each of appellants' independent claims.

Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of claims, 1, 23, and 25. the rejection of claims 1, 23, and 25 under 35 U.S.C. § 103(a) is therefore reversed.

In addition, we reverse the rejection of dependent claims 2-4, 24 and 26 because the additional references to Kodama and Takasu, relied upon by the examiner (answer, pages 6-8) do not make up for the deficiencies of the basic combination of Tabata and Tosaki.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4 and 23-26 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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